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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
WINDER, PATRICE L

ART UNIT	PAPER NUMBER
2145	

NOTIFICATION DATE	DELIVERY MODE
04/25/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

MN

Office Action Summary	Application No.	Applicant(s)	
	09/095,325	EGGLESTON ET AL.	
	Examiner	Art Unit	
	Patrice Winder	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *October 23, 2007 and February 14, 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-68* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2-14-2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 23, 2007 has been entered.

Inventorship

2. In view of the papers filed October 23, 2007, the inventorship in this nonprovisional application has been changed by the deletion of Richard Krebs.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Review of 1.131 Affidavits

3. The affidavit filed on February 14, 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Shirakihara reference.

4. The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Shirakihara reference.

5. An effective affidavit under 37 C.F.R 1.131 has two components: 1) an indication of basis for the affidavit and 2) accompanying evidence to the support the affidavit. After reviewing the affidavit filed on February 14, 2008, at least two deficiencies have been discovered. First, the affidavit is silent as to whether Applicant is using conception or reduction to practice as a basis for the affidavit. Second, the evidence provided uses the screen shots from the interview on May 17, 2007 with the inventors and Applicant's representatives were provided. However, these screenshot cannot be used to substantiate Applicant's claim of possession of the inventive subject prior to the date of the Shirakihara reference (e.g. June 7, 2007) unless the screenshots are "original exhibits". The affidavits appear to lack information as to the origin of the screenshots.

6. A possible remedy to perfect Applicant's affidavit should the screen shots not be "original exhibits" is to emphasize the underlying computer code and the user manual that discloses the screen shots. It would appear from the statements made by the inventors in the affidavits filed on February 14, 2008 that Applicant is relying on particular software modules of AirMobile® to implement the claimed invention. In that case, the best approach would be to map the software modules, respective lines of code or original comments to a claimed function without relying on the screen shots.

Response to Arguments

7. Applicant's arguments, see the remarks on pages 6-7, filed October 23, 2007, with respect to the rejection(s) of claim(s) 56-63, 65 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a new prior art reference.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 56-63, 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al., USPN 5,742,668 (hereafter referred to as Pepe) in view of Mullan, USPN 5,493,564 (hereafter referred to as Mullan).

11. Regarding claim 56, Pepe taught a computer system for forwarding messaged from a mobile client (abstract) comprising:

a host system capable of sending and receiving messages, wherein a message sender's email address is associated with host system (column 5, lines 7-13; column 18, lines 1-16);

a forwarding component operable with the host system that upon receiving a message generated at the mobile client, by a message sender destined for a message recipient (column 18, lines 16-20). Pepe does not specifically teach configuring the received message. However, Mullan taught a forwarding component configures the received message, prior to forwarding to the message recipient such that the received message appears to the message recipient as if the received message originated at the sender's email address associated with the host system (column 7, lines 34-37; column 8, lines 18-25), thereby allowing messages generated at either the mobile client or host system to originate at the sender's email address associated with the host system (column 8, lines 25-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Mullan's configuring the received message in Pepe's forwarding component would have improved global routing of messages between multiple electronic messaging systems. The motivation would have been to provide better global routing by compensating for user address information changes due to location changes.

12. Regarding claim 60, Pepe taught a method for forwarding messages generated at a mobile client by a message sender destined for a message recipient (subscriber message delivery and receipt, abstract), comprising the steps of:

receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system (column 18, lines 16-20), and forwarding the received message to the message recipient (column 18, lines 16-20). Pepe does not specifically teach configuring the received message. However, Mullan taught messages generated at the host system by the message sender use a first address (column 7, lines 26-37); configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address (column 7, lines 34-37; column 8, lines 18-25), wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address (column 8, lines 25-32); and forwarding the configured received message to the message recipient (column 11, lines 56-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Mullan's configuring the received message in Pepe's forwarding component would have improved global routing of messages between multiple electronic messaging systems. The motivation would have been to provide better global routing by compensating for user address information changes due to location changes.

13. Regarding dependent claim 57, 61, Mullan taught an email address field in the configured received messages is the message sender's email address associated with the host system (column 8, lines 27-32).

14. Regarding dependent claim 58, 62, Pepe taught a reply-to email address field in the configured received message is the message sender's email address associated with the host system (part of text message format, column 23, lines 28-29).

15. Regarding dependent claim 59, 63, Pepe taught a computer system further comprising a code added to the configured received message to make an indication to the message recipient (column 24, lines 37-50).

16. Regarding claim 65, Pepe taught a computer readable medium encoded with software instructions for enabling a method of forwarding messages generated at a mobile client by a message sender destined for a message recipient (subscriber message delivery and receipt, abstract), the method comprising the steps of:

receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system (column 18, lines 16-20),

configuring the received message such that the received message appears as if it were generated at the mobile client (column 18, lines 5-6; column 23, lines 1-6). Pepe does not specifically teach configuring the messages. However, Mullan taught wherein messages generated at the host system by the message sender use a first address (column 7, lines 26-37); configuring the received message such that the received message appears as if it were generated at the mobile client or host system (column 7,

lines 34-37; column 8, lines 18-25); and forwarding the configured received message to the message recipient (column 11, lines 56-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Mullan's configuring the received message in Pepe's forwarding component would have improved global routing of messages between multiple electronic messaging systems. The motivation would have been to provide better global routing by compensating for user address information changes due to location changes.

17. Claims 33-34, 40-47, 54-55 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara et al., USPN 5,941,956 (hereafter referred to as Shirakihara) in Perkins, USPN 5,159,592 (hereafter referred to as Perkins).

18. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara and Perkins as applied to claim 34 above, and further in view of Dunn, USPN 5,659,596 (hereafter referred to as Dunn).

19. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara and Perkins as applied to claim 33, above, and further in view of Pepe.

20. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara as applied to claim 33 above, and further in view of Pepe.

21. Claims 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe in view of Dunn.

22. Regarding claim 33, Shirakihara taught a method of forwarding messages between a host system and a mobile client (abstract), comprising the steps of:

establishing a session based on loaded parameters at the host system (column 8, lines 3-13);

querying the host system (column 8, lines 3-13);

receiving messages directed to a first address at the host system from a plurality of message senders (column 7, lines 34-41; column 8, lines 14-18);

in response to a query, continuously forwarding the messages from the host system to the mobile client (column 8, lines 21-44);

generating reply messages at the mobile client to be sent to the plurality of message senders and transmitting the reply messages to the host system (column 8, lines 48-53);

receiving the reply messages at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system (Response message M(A1,a2) sent to conversion device 3-2 and becomes M(A1,A2). Response message M(A1,A2) sent to conversion device 3-1 and becomes M(a1, A2).); and

transmitting the reply messages from the host system to the plurality of message senders (column 8, lines 48-53). Shirakihara does not specifically teach maintaining the session at host system. However, Perkins taught maintaining the session at the host system (column 3, lines 63-68; column 6, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Perkins's step of maintaining the session in Shirakihara's method for forwarding messages would

have would have improved reliability. The motivation would have been to ensure packets are routed to migrating mobile clients (Perkins, column 2, lines 65-66).

23. Regarding dependent claim 34, Shirakihara taught the method further comprising the step of: storing information regarding the configuration of the mobile client at the host system (column 8, lines 7-13).

24. Regarding dependent claim 35, Shirakihara taught the configuration information stored at the stored at the host includes (A) the network address of the mobile client (column 8, lines 7-13). Shirakihara does not specifically teach the host include (B) an indication of the types of the message attachments that the mobile client will receive and process. However, Dunn taught a host includes (B) an indication of the types of the message attachments that the mobile client will receive and process (column 15, lines 17-23; column 19, lines 27-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Dunn's message type in Shirakihara-Perkins method of forwarding messages would have improved system robustness. The motivation would have been to route messages to roaming target users without the message senders needing to have detailed information about the mobile client (Dunn, column 1, lines 9-16).

25. Regarding dependent claim 36, Dunn taught the configuration information further includes: (C) an indication of the protocol of the mobile client (column 22, lines 46-59).

26. Regarding dependent claim 37, Shirakihara-Perkins does not specifically teach whether the messages include an attachment. However, Dunn taught a method for forwarding messages further comprising the steps of:

for each message to forwarded, the host system determining whether the message includes an attachment, and if so then determining the type of attachment (column 23, lines 40-42);

accessing the stored configuration information at the host system to determine whether the mobile client will receive and process attachments of the determined type (column 23, lines 40-47); and

if so, then forwarding the attachments to the mobile client (column 30, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Dunn's message type in Shirakihara-Perkins method of forwarding messages would have expanded system flexibility by including more message types. The motivation would have been to route messages to roaming target users without the message senders needing to have detailed information about the mobile client (Dunn, column 1, lines 9-16).

27. Regarding dependent claim 38, Dunn taught the type of attachment is a sound file (column 15, lines 15-17).

28. Regarding dependent claim 39, Shirakihara taught the received messages are address using a sender address and a receiver address (column 7, lines 53-57), the method further comprising the steps of:

determining whether the receiver address is associated with the mobile client (column 8, lines 14-29);

if the receiver address is associated with the mobile client, then determining a network address of the mobile client and packetizing the messages using the receiver address and the network address of the mobile client (column 8, lines 14-29); and

after receiving the forwarded messages at the wireless subscriber unit, so that it appears as though the mobile client is the host system (column 8, lines 45-53). Shirakihara-Perkins does not specifically teach displaying the messages at the mobile client using the sender address and the receiver address. However, Pepe taught displaying the messages at the mobile client using the sender address and the receiver address (column 18, lines 1-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Pepe's displaying messages in Shirakihara-Perkins' system for forwarding messages would have provided an equivalent mechanism for viewing messages. The motivation would have been to allow the receiver to access forwarded messages.

29. Regarding dependent claim 40, Shirakihara taught the parameters of the established session at the host system include external events (column 8, lines 3-13) or internal events (column 8, lines 8-13). Perkins taught the parameters of the established session at the host system include network events (column 6, lines 8-18).

30. Regarding dependent claim 41, Shirakihara taught the external event is a registration message from the mobile client (column 8, lines 3-13).

31. Regarding dependent claim 42, Shirakihara taught the internal event is an execution of control messages (execution of response registration messages, column 8, lines 3-13).

32. Regarding dependent claim 43, Shirakihara the internal event is an execution of programs (programs to respond to registration, column 8, lines 3-13).

33. Regarding dependent claim 44, Perkins taught the internal event is a timer operation (column 5, lines 34-42).

34. Regarding dependent claim 45, Perkins taught the networked events include messages to begin forwarding from computer systems other than the mobile client, which are connected to the host system via wired network (column 6, lines 8-18).

35. Regarding dependent claim 46, Shirakihara taught the mobile client is a mobile station (column 7, lines 34-41).

36. Regarding dependent claim 47, Dunn taught the mobile client is a device equipped to receive both voice and non-voice data messages (column 15, lines 17-23).

37. Regarding dependent claim 48, Shirakihara-Perkins does not specifically teach the host system includes a client profile database limiting the forwarding step to forwarding only those messages that are transmitted to the host system from a sender stored in the database. However, Pepe taught a host system includes a client profile database limiting the forwarding step to forwarding only those messages that are transmitted to the host system from a sender stored in the database (column 5, lines 45-54; column 6, lines 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Pepe's client profile database in Shirakihara-Perkins' system for forwarding messages to mobile clients would have improved system robustness. The motivation would have been to reduce the consumption of system resources by not sending unwanted messages.

38. Regarding dependent claim 49, Pepe taught a user can add and subtract senders from the database (column 27, lines 9-12).

39. Regarding dependent claim 50, Pepe taught a user can add and subtract senders from the database by configuring the host system (column 27, lines 15-24).

40. Regarding dependent claim 51, Pepe taught a user can add and subtract senders from the database by transmitting a command message from the mobile client to the host system (column 27, lines 15-24).

41. Regarding dependent claim 52, Pepe taught an active client profile database is activated and deactivated at the host (column 6, lines 47-59; column 26, lines 43-47).

42. Regarding dependent claim 53, Pepe taught an active client profile database is activated and deactivated from the mobile client (column 26, lines 43-47).

43. The language of claims 54-55, 64 is substantially the same as previously rejected claim 33, above. Therefore, claims 54-55, 64 are rejected on the same rationale as previously rejected claim 33, above.

44. Regarding dependent claim 66, Pepe does not specifically teach maintaining the session. However, Dunn taught a method of forwarding message comprising the steps of:

establishing a session with the host system based on loaded parameters (column 9, lines 51-55);

maintaining the session with the host system and querying the host system (column 9, lines 46-51);

continuously forwarding the received messages from the host system to the wireless mobile client associated with the host system (column 17, lines 46-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made Dunn's maintaining a session in Pepe's system for forwarding messages would improved system robustness. The motivation would have been to reduce the number of messages are lost to being out of range.

45. Regarding dependent claim 67, Pepe taught the session is an execution of programs (column 16, lines 1-11).

46. Regarding dependent claim 68, Pepe taught a method further comprising the steps of:

loading parameters at the host system (column 16, lines 1-11);

filtering received messages at the host system using one or more message filter prior to forwarding messages to the wireless mobile client (column 10, lines 33-43).

Conclusion

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patrice L. Winder

Patrice Winder
Primary Examiner
Art Unit 2145

February 24, 2008